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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Lianli Ji, et al.
Serial Number: 09/801,489
Filed: March 7, 2001
For: GRAVITY-SENSITIVE LATCH
Art Unit: 3677
Examiner: Gary W. Estremsky
Attny Docket No: 055-01

RESPONSE TO SECOND REQUIREMENT FOR RESTRICTION

Commissioner for Patents
Washington, D.C. 20231

Sir:

Background:

On May 15, 2001, the Examiner mailed a first requirement for restriction and request for election of species reciting that claims 1-57 were pending. Applicants were required to elect between Group I - Figures 1-14 and Group II - Figures 15-57. (There are 57 figures pending in this application.) In response, applicants elected Group II - Figs. 15-57 and identified claims 23-57, and in addition added a "generic" claim 58, which by definition recites the elected Group II.

This Invention:

The invention is "gravity-sensitive" latch, which in a first orientation such as horizontal, may be operated. In a second orientation such as vertical, i.e., at 90° to the first, the latch cannot be operated. Like all mechanically operated latches, this latch includes: an activator means (paddle, handle, button, operator means); a pawl (catch means); a housing (case, bracket) for maintaining the spatial relationship of the elements; and an associated keeper (or equivalent) that can be engaged by the pawl.

Point of Novelty:

The novel and unobvious difference in this "gravity-sensitive" latch is that the mechanical connection between the paddle and the pawl includes a pendulum-like link, which swings out to dislocate (disconnect, breaks, un-connect, unlink) the connection between the activator and the pawl. With the mechanical connection between the paddle and the pawl disconnected, the paddle is free to move by an operator, but to no effect. The pendulum link of the present invention is not a "lockout" device, but a disconnect device.

Further Background:

On July 20, 2001, the Examiner mailed a non-final Office Action after examining claims 23-58, thereby rejecting claims 23-36, 38-53, and 55-58, while objecting to claims 37 and 54. In this Office Action the Examiner disputed applicants' assertion that new claim 58 is generic and provided support for his position of claim 58 reading only on Group II. In response, applicants canceled claims 37 and 54 and amended independent claims 23, 41 and 58 and dependent claim 26.

On March 20, 2002, the Examiner issued a notice of allowance of claims 23-26 and 55-58. In response, on June 24, 2002, applicants filed: a supplemental IDS; an RCE; a request for a temporary suspension; and a supplemental amendment which added new claims 59-78, reciting the invention of the previously elected Group II.

On October 15, 2002, in response to the RCE and supplemental amendment, the Examiner mailed a non-final Office Action requesting applicants state which of the pending claims read on the elected embodiment (Group II). In response, applicants replied that pending previously amended claims 23-36, 38-53, and 55-58 are directed to Group II - Figs. 15-57, and new claims 59-78 are likewise directed to Group II - Figs. 15-57.

Upon further reflection, the Examiner has now on January 13, 2003, issued a second requirement for restriction and requested an election between Group IIa - Figs. 15-33 and

Group IIb - Figs. 34-57. The Examiner has remarked that none of the pending claims 23-36, 38-53 and 55-78 appear generic to his now defined as two species (IIa and IIb). However, as the Examiner has now divided the previous Species, Group II - Figs. 15-57 into two sub-groups, applicants believe sub-species is proper. The required election is between "sub-species", Group IIa - Figs. 15-33 and "sub-species", Group IIb - Figs. 34-57.

Basis Restriction Practice in Statue and Rules:

35 USC 121 recites:

"If two or more independent and distinct **inventions are claimed** in one application, the Director may require the application to be restricted to one of the inventions. [emphasis added]

37 CFR 1.142 recites:

"(a) If two or more independent and distinct **inventions are claimed** in a single application, the examiner in an Office action will require the applicant in the reply to that action to elect an **invention to which the claims will be restricted**, this official action being called a requirement for restriction..." [emphasis added]

"(b) Claims to the invention or inventions not elected, if not canceled, are nevertheless withdrawn from further consideration..."

MPEP 803 recites:

"Under the statute an application may properly be required to be restricted to one of two or more **claimed inventions only** if they are able to support **separate patents** and they are **either independent** (MPEP § 806.04 - § 806.04(i)) or **distinct** (MPEP § 806.05 - § 806.05(i))." [emphasis added]

MPEP 803 further recites:

"CRITERIA FOR RESTRICTION...

There are two criteria for a proper requirement for restriction...

(A) The inventions must be independent...; **and**

(B) There must be a serious burden on the examiner..." [emphasis added]

"GUIDELINES

Examiners must provide reasons and/or examples to support conclusions...

Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctiveness must be demonstrated to support a restriction requirement.

If there is an express admission that the claimed inventions are obvious over each other within meaning of 35 USC 103, restriction should not be required. *In re Lee*, 199 USPQ 108 (Comm'r Pat. 1978).

For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02. That *prima facie* showing may be rebutted by appropriate showings or evidence by the applicant."

Traversal of the Second Restriction Requirement:

Applicants hereby respectfully TRAVERSE the outstanding restriction requirement as being improperly made in violation of: 35USC121; 37CFR1.142; and MPEP 803. While the present practice among many members of the examining corps has changed recently, to the practice of analyzing an application for restriction, based upon a reading the specification to recite more than one embodiment, and a review of the drawings to show more than one embodiment, that practice is contrary to the Statute and Rules. The statute stipulates that the "claim invention(s)" are the subject matter of a restriction requirement. The Rules mandate that the application must "claim" two or more independent and distinct inventions. The MPEP contains the proviso that an examiner can only reach the "burden" criteria after he justifies the "plural independent" inventions criteria and both must be shown before a restriction can be raised. The burden of searching more than one class can only be addressed after a proof of plural independent inventions is shown. In fact, patented inventions are commonly cross-referenced into more than one class.

Discussion of the Embodiments:

Applicants' drawings and specification (specifically their Detailed Description) describe three (3) embodiments. However, a separate embodiment does not *per se* define a separate invention. An "embodiment" is: *a thing in which something (as a soul, idea, principle, or type) is embodied*. See Webster's Third New International Dictionary, Unabridged, (1961).

"Independent" is defined among other meanings to mean: *not affiliated with or integrated into a larger controlling unit*. See Webster's, *supra*.

MPEP 802.01 defines "independent" as:

"INDEPENDENT

The term 'independent (i.e., not dependent) means that there is **no disclosed relationship** between the two or more subjects disclosed, that is, they are **unconnected in design, operation, or effect**, for example: (1) species under a genus which species are not usable together as disclosed; or (2) process and apparatus incapable of being used in practicing the process." [emphasis added].

MPEP 802.01 also defines "distinct" as:

"DISTINCT

The term 'distinct' means that two or more subjects as disclosed are related, for example, as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale **as claimed, AND ARE PATENTABLE** (novel and unobvious) **OVER EACH OTHER** (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term **"related"** is used as an **alternative for "dependent"**... [emphasis added]

Every examiner must first give alternate embodiments the presumption of dependence, because by definition they embody the same "focus of the invention" or "point of novelty", i.e., they embody the **same design, operation or effect**.

Therefore, two embodiments comprising two "sub-species" of a previously defined "species" must be first accorded the presumption of embodying the same *claimed invention*, unless they are expressly demonstrated otherwise.

Applicants' first embodiment is shown in Figs. 1-14, with Fig. 1 showing the assembly thereof and Fig. 3 showing an exploded view of the assembly. This embodiment is recited in claims 1-22. This first embodiment **claimed invention** [claim 1] is recited to include: a housing (100a), a "slidable" button (200a), a pendulum (300), a pawl (400), means (208a) for securing the housing and button, means (308) for pivotally securing the housing and pawl, and means (500a) for operatively connecting the pendulum and pawl. Claims 2-22 each directly or indirectly depend from claim 1.

Applicants' second embodiment is shown in Figs. 15-33, with Fig. 15 showing the assembly thereof and Fig. 16 showing an exploded view of the assembly. This second embodiment **claim d invention** [claim 23] is recited to include: a housing (100b), a "pivotally

secured" handle (200a), a "pivotally secured" pawl (400b), a "pivoting" pawl-retaining arm (700b), a pendulum (300), means (704b) for pivotally securing the housing and pawl, wherein the pawl has upper and lower forward arms (442b, 444b) with a channel (448b) there between, and a rearward arm (446b). Claims 24-36, directly or indirectly depend from claim 23.

Applicants' third embodiment is shown in Figs. 34-57, with Figs. 34-38 each showing the assembly thereof from a different angle, and Figs. 39-40 showing the exploded view thereof. However, applicants' third embodiment comes with a cylinder lock (802) and without this lock. When this lock (802) is present, so is the locking arm (850). In this regard, the Examiner's attention is directed to the latch with lock (Figs. 39) and the latch without lock (Fig. 40).

The third embodiment (Figs. 39 and 40) **claimed invention** [claim 41] is recited to include: a housing (100c), a button (200c) supported for "slidable" movement, a pendulum (300) connected to the button, a pawl (400c) pivotally secured to the pendulum, means (490c, 452c, 104c) for pivotally securing the housing and pawl, wherein said means is a rod (490c). 42-57 directly or indirectly depend from claim 41.

Added New Claim 58:

New independent claim 58 was added, on about June 18, 2001, as part of the response to the first requirement for restriction. In so doing the applicants asserted that this new claim 58 was generic. The Examiner refuted this by remarking that:

"claim 58 is not generic as it requires a pawl pivotally secured to said housing, whereas the invention of Group I has a pawl that is linearly, slidably mounted in such a way that it cannot pivot".

In this regard, the Examiner examined new claim 58 as part of Group II.

In support of applicants' traversal of the outstanding second requirement for restriction, applicants assert that new claim 58 as first added, and as amended on about January 16, 2002, is generic to **both** "sub-species" Group IIa and IIb, for the following reason.

The **claimed invention** recited in claim 58 as originally filed, includes: a housing (100b or 100c), a button (200b or 200c) secured to the housing, a pendulum (300) in communication with the button, and a pawl (400b or 400c) pivotally secured to the housing.

However, claim 58 was thereafter amended to recite the additional limitations of the pawl having a plurality of arms (442b, 444b, 446b), a pawl retaining arm (700b or 454c), and means (704b or 490c) pivotally securing the pawl retaining arm to the housing. This **claim invention** is illustrated in Figs. 15-16 and not in Figs. 34-40).

If the limitation reciting the "claw-shaped" pawl were to be deleted by a further amendment, then the twice amended claim 58 would recite the invention disclosed in reference to both Figs. 15-16 and 34-40, i.e., "sub-species" Groups IIa and IIb. This has been done below.

New Claims 59-78:

Of the new claims entered into this application with the supplemental amendment filed with the supplemental IDS and the RCE on June 24, 2002, claims 59 and 60 are independent claims and claims 61 and 64-78 depend directly or indirectly from claim 59, while claims 62 and 63 depend directly or indirectly from claim 60.

The **claimed invention** recited in claim 59 includes: a housing (100a or 100b or 100c), a pawl (400a, 400b, 400c) mounted to said housing for movement relative thereto, means (900a or 902b or 906c) connected to said pawl for biasing its position, a manually operated activator (200a or 200b or 200c) structure mounted to said housing; an interlocking means (700b or 850) mounted to said housing for selectively engaging said pawl for locking it against movement, means (902b or 802) connected to said interlocking means for biasing its position, linking means (300), having an interposed position and a non-interposed position, for transferring the manually operated motion of said activator structure to aid interlocking means thereby altering its engagement with said pawl, when said linking means is in its interposed position between

said activator structure and said interlocking means; wherein said linking means is gravity-sensitive to move between its interposed position and its non-interposed position as a function of said housing physical orientation.

The **claimed invention** of claim 59 clearly reads on both "sub-species" Groups IIa and IIb because there is no recited, distinguishable sub-species limitations for:

1. how the pawl is mounted to the housing, just that it is connect for movement;
2. no limitation on the type of means biasing the pawl, nor how biased, nor biased to which position;
3. no limitation on how the activator structure is mounted to the housing, nor any limitation on its shape or on how the activator moves;
4. no limitation of the size, shape, position or mounting method for the interlocking means to engage the pawl, nor any limitation as to whether this means engages the pawl directly or indirectly;
5. no limitation on the nature, method of operation or method for the biasing means which biases the interlocking means position both the spring and the lock cylinder meet this recitation).

The **claimed invention** of claim 60 includes: a housing (100a or 100b or 100c), a keeper engaging member (400a or 400b or 400c) mounted to said housing for movement relative thereto, means (900a or 902b or 906c) connected to said pawl [sic - keeper engaging means] for biasing its position, manually operated activator structure (200a or 200b or 200c) mounted to said housing, and linking means (300+500a or 300+204b or 300+208c), having an interposed position and a non-interposed position, for transferring the manually operated motion of said activator structure to said pawl [sic - keeper engaging means] when said linking means is in its interposed position, wherein said linking means is gravity-sensitive to move between its interposed position and its non-interposed position as a function of said housing physical orientation.

Without the 35 USC 112 issues raised by [sic] above, the claimed invention of claim 60 is generic to both sub-species Groups IIa and IIb.

Kindly amend claims 58, 60 and 62-63 as follows.

58. (Twice Amended) A gravity-sensitive latch comprising:

a housing;

a handle secured to said housing;

a pendulum operatively in communication with said handle, said pendulum pivoting between [a latched] an operation position and [an unlatched] a non-operation position under the force of gravity;

a pawl [having a plurality of arms extending therefrom,] pivotally [secured] connected to said housing [, said pawl being dimensioned and configured to engage a keeper, said pawl] for pivoting between a latch[ed] position and an unlatch[ed] position

a pawl-retaining arm for engaging or disengaging with said pawl by pivoting between a [latched] first position and [an unlatched] a second position; and

means for pivotally securing said housing and said pawl-retaining arm.

60. (Amended) A gravity-sensitive latch, comprising:

a housing;

a [keeper engaging member mounted] pawl connected to said housing for movement relative thereto;

means connected to said pawl for biasing its position;

a manually operated activator structure mounted to said housing for movement; and

linking means, having an interposed [position] state and non-interposed [position] state, for transferring the manually operated motion of said activator structure to said pawl when said linking means is in its interposed [position] state;

wherein said linking means is gravity-sensitive to move between its interposed [position] state and its non-interposed [position] state [as a function of said housing physical orientation].

62. (Amended) The gravity-sensitive latch of claim 60, wherein said linking means moves to its interposed [position] state when said housing is moved to a horizontal position and wherein said linking means moves to its non-interposed [position] state when said housing is moved to a vertical position.

63. (Amended) The gravity-sensitive latch of claim 62, also including:

a key operated lock operable between a locked position and an unlocked position; and

a locking structure connected to said lock for movement when said key operated lock is turned;

wherein said locking structure intercepts said linking means when said lock is in the locked position, whereby said locking structure [fixes] biases said linking means in its non-interposed position.

Pursuant to 37 CFR 1.121, clean copies on a separate page(s) follow below.